

ESTTA Tracking number: **ESTTA531286**

Filing date: **04/09/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Allstate Insurance Company
Granted to Date of previous extension	04/10/2013
Address	2775 Sanders Road Northbrook, IL 60062 UNITED STATES
Correspondence information	Marsha Hoover Marshall, Gerstein & Borun LLP 233 S. Wacker Drive Suite 6300 Chicago, IL 60606 UNITED STATES mhoover@marshallip.com,rlabarge@marshallip.com Phone:(312) 474-6300

Applicant Information

Application No	79118763	Publication date	12/11/2012
Opposition Filing Date	04/09/2013	Opposition Period Ends	04/10/2013
International Registration No.	1131362	International Registration Date	07/06/2012
Applicant	YONETANI Takushi 1-5-22 Iguchido Ikeda; Osaka 563-0023 JAPAN		

Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Tires for motorcycles; tires for automobiles


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	761091	Application Date	01/17/1963
Registration Date	12/03/1963	Foreign Priority Date	NONE
Word Mark	ALLSTATE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U102 (International Class 036). First use: First Use: 1931/04/17 First Use In Commerce: 1931/04/17 Business of Making, Writing, and Underwriting of Insurance

U.S. Registration No.	759366	Application Date	06/19/1961
Registration Date	10/29/1963	Foreign Priority Date	NONE
Word Mark	ALLSTATE MOTOR CLUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1961/05/18 First Use In Commerce: 1961/05/18 Services to Motorist Members, Including Assistance on Planning Auto Trips, Emergency Road Service Benefits, Legal Service Benefit in Event of Traffic Violation Charges, Accident Insurance, and Arranging for World-Wide Tours		

U.S. Registration No.	3833066	Application Date	11/13/2008
Registration Date	08/10/2010	Foreign Priority Date	NONE
Word Mark	ALLSTATE DEALER SERVICES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2008/11/14 First Use In Commerce: 2008/11/14 Insurance underwriting services in the field of auto protection, excess wear and tear protection, gap, vehicle service contracts and credit life insurance; prepaid preventive maintenance service plans for automobiles Class 037. First use: First Use: 2008/11/14 First Use In Commerce: 2008/11/14 Automotive maintenance and repair; emergency roadside assistance services, namely, responding to calls for roadside assistance, flat tire changing, emergency fuel supplying, and battery jump starting		

Attachments	72122247#TMSN.gif (1 page)(bytes) 77979833#TMSN.jpeg (1 page)(bytes) allstatetireopp.pdf (5 pages)(694520 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/rmlabarge/
Name	Richard M. LaBarge
Date	04/09/2013

Allstate Insurance Company,)	
)	
Opposer,)	Opposition no. _____
)	
v.)	Serial no. 79118763
)	
Takushi YONETANI,)	Mark: ALLSTATE
)	
Applicant.)	
)	

ALLSTATE is one of the best-known brands in America. The mark began as a tire brand and, for forty years, Allstate and its affiliated companies sold both tires and auto insurance:

[illegible]

Now, an individual from Japan is trying to register the ALLSTATE mark for his own tires.

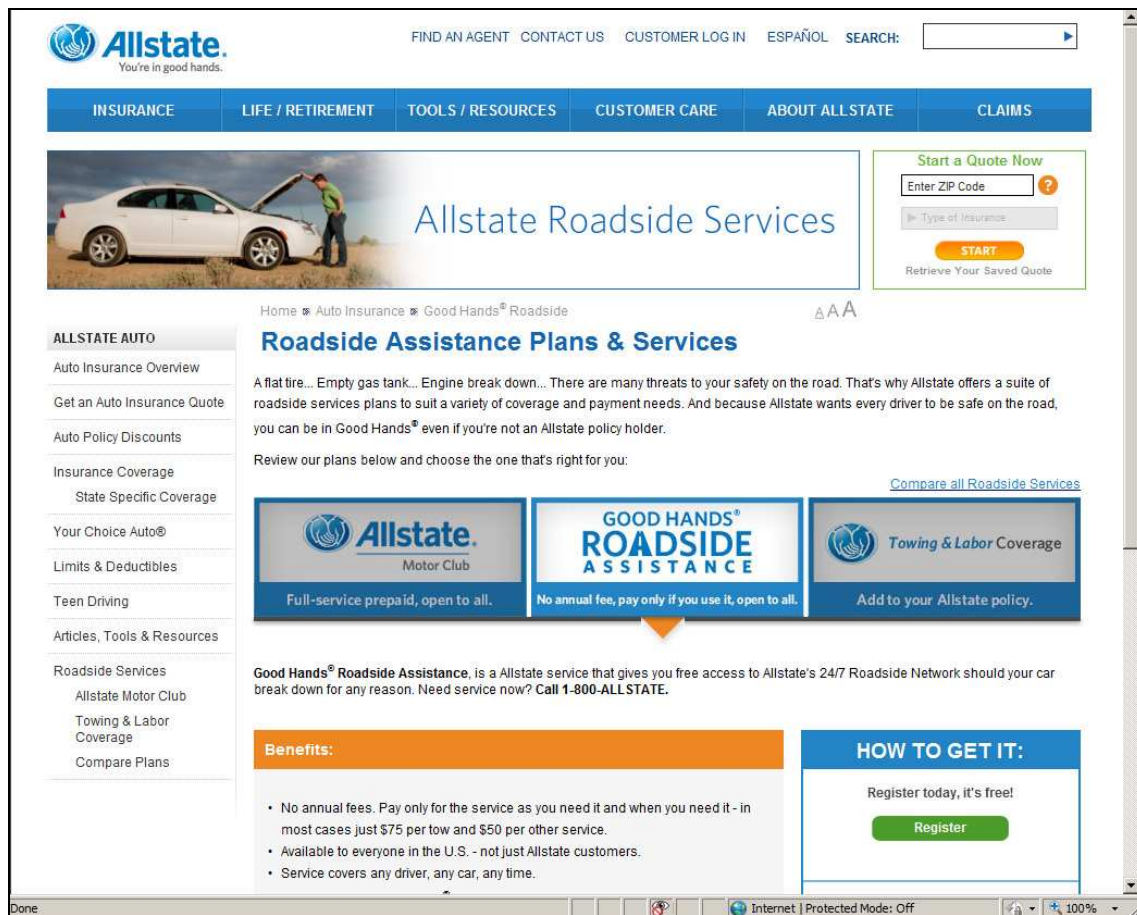
Allstate Insurance Company is an Illinois insurance company with a principal place of business at Allstate Plaza, Northbrook, IL 60062 (“Allstate”). It opposes application ser. no. 79118763 (“the opposed application”) filed by Takushi Yonetani (“Mr. Yonetani”) to register ALLSTATE for tires. Allstate would be damaged by registration of the designation because it has prior rights in ALLSTATE in connection with related services, and because use of ALLSTATE in connection with Mr. Yonetani’s tires would blur the distinctiveness of Allstate’s mark.

The grounds for opposition are:

1. Allstate is one of the nation’s leading insurance companies.
2. In 1925, Allstate’s predecessor developed a new automobile tire and held a national contest to name it. The ALLSTATE mark was selected from over two million entries; the company paid the winner \$5000.
3. The ALLSTATE brand was expanded to include auto insurance in the 1930s. In the 1950s, a company affiliate expanded the ALLSTATE brand to cars. By the end of that decade, car sales had stopped but use of the mark on auto batteries and tires continued while the insurance company served more than 5 million policyholders.



4. Aside from its insurance business, Allstate today offers a suite of roadside service plans that protect drivers on the road. The first threat listed in its current website promotion: a flat tire.



Allstate's *Good Hands*® Roadside Assistance plan is offered to all, not just Allstate policyholders, and in the last two years alone, more than 1,000,000 people have signed up for its benefits.

5. Today, Allstate owns more than fifty federal trademark registrations that include the word ALLSTATE, including both of the following registrations that have incontestable status:

Reg. no.	Mark	Services
761091	ALLSTATE	Business of making, writing, and underwriting of insurance
759366	ALLSTATE MOTOR CLUB	Services to motorist members, including emergency road service benefits

5. Tires and auto insurance are sufficiently related that use of ALLSTATE on tires will cause a likelihood of confusion. The close relationship between the two is manifest in another of Allstate's registrations:

Reg. no.	Mark	Services
3833066	ALLSTATE DEALER SERVICES	Insurance underwriting services in the field of auto protection, excess wear and tear protection, gap, vehicle service contracts and credit life insurance; prepaid preventive maintenance service plans for automobiles. (IC 36) Automotive maintenance and repair; emergency roadside assistance services, namely, responding to calls for roadside assistance, flat tire changing, emergency fuel supplying, and battery jump starting. (IC 37)

6. ALLSTATE so resembles Allstate's previously used ALLSTATE mark as to be likely, when used on or in connection with Mr. Yonetani's tires, to cause confusion, or to cause mistake, or to deceive. Consequently, registration is precluded by 15 USC 1052(d).

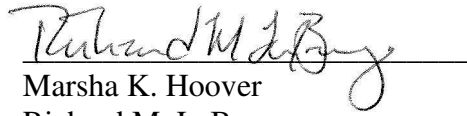
7. Mr. Yonetani's proposed use of ALLSTATE is also likely to cause dilution by blurring the significance of Allstate's famous ALLSTATE mark. Consequently, registration is precluded by 15 USC 1063(a).

Accordingly, the opposition should be sustained and the registration should be refused.

Respectfully submitted,

Allstate Insurance Company

By:



Marsha K. Hoover

Richard M. LaBarge

MARSHALL, GERSTEIN & BORUN LLP

6300 Sears Tower

233 South Wacker Drive

Chicago, Illinois 60606

(312) 474-6300

April 9, 2013

CERTIFICATE OF SERVICE

I certify that this document is being served on the applicant on April 9, 2013, by mailing a copy by first class mail, postage prepaid, to the correspondent of record for the applicant:

TANAKA Satoshi

4-4-28 Kouda, Ikeda

Osaka 563-0043 JAPAN



Richard M. LaBarge